

## **REMARKS**

### **STATUS OF CLAIMS**

Claims 1-50 are pending. Claims 1, 4, 11, 17, 21, and 38 are amended. Claims 51 and 52 are new. Claims 4, 11, and 17 are amended to correct minor informalities. No new matter is added. Claims 1, 21, and 38 are amended to more particularly claim the subject matter of the present invention. Support for these amendments can be found at page 24, line 26 through page 27, line 11, including the table on page 26. No new matter is added. New claims 51 and 52 find support throughout the specification, for example, at page 24, line 26 through page 27, line 11, including the table on page 26. No new matter is added.

### **CLAIM OBJECTIONS**

Claims 4, 11, and 16 are objected to for containing informalities. The cited informalities are corrected in the present amendments. Therefore, the objection with respect to these claims should be removed.

Applicants would like to thank the Examiner for renumbering claims 50 and 51 as claims 49 and 50, respectively.

### **REJECTIONS UNDER § 102**

#### **US 6,300,290 (L'Heureux)**

Claims 1-4, 6, 8-10, 15-17, 21-24, 26, 28-30, and 35-37 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by US 6,300,290 to L'Heureux ("L'Heureux"). This rejection is traversed for at least the following reasons.

Nothing in L'Heureux discloses, teaches, or suggests anything about the power transmission fluid composition of claim 1 or the method of improving shear stability for a transmission fluid of claim 21 comprising a polyisoalkylene component and having a friction versus velocity curve with a more positive slope at high speeds compared to a fluid not containing polyisoalkylene. Further, L'Heureux does not disclose, teach, or suggest a fluid composition or method that has a friction drop at high speeds of less than about 0.008.

L'Heureux discloses an oil composition useful as a two-cycle oil or an engine oil. An engine oil is different from a power transmission fluid. One of skill in the art reading L'Heureux would learn nothing about fluid components or properties for use as a power transmission fluid. Even further, one reading L'Heureux would learn nothing about obtaining a friction versus velocity curve with a more positive slope at high speeds for power transmission fluids.

The presently claimed invention provides a significant improvement over the prior art by providing a transmission fluid that provides a small friction drop at high speeds. See for example, the Table on page 26 in which transmission fluid VIIA has a friction drop of less than 0.008 at max-min and max-300 compared to transmission fluids not containing the polyisoalkylene of the presently claimed invention. The only way to arrive at the presently claimed invention after reading L'Heureux is upon impermissible hindsight after reading the present application.

Therefore, independent claims 1 and 21 and their dependent claims are novel over L'Heureux. For the same or similar reasons, new claims 51 and 52 are likewise novel over L'Heureux.

US 6,444,622 (Bala) in view of Performance Filtration, Inc., Mark Barnes, and Science and Engineering Encyclopedia

Claims 1-17 and 21-37 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by US 6,444,622 to Balasubramaniam ("Bala") in view of the evidence given in Performance Filtration, Inc., Mark Barnes, and Science and Engineering Encyclopedia. This rejection is traversed for at least the following reasons.

Nothing in Bala discloses, teaches, or suggests anything about the power transmission fluid composition of claim 1 or the method of improving shear stability for a transmission fluid of claim 21 comprising a polyisoalkylene component and having a friction versus velocity curve with a more positive slope at high speeds compared to a fluid not containing polyisoalkylene. Further, Bala does not disclose, teach, or suggest a fluid composition or method that has a friction drop at high speeds of less than about 0.008.

Bala discloses an oil composition useful as a gear oil. An gear oil is different from a power transmission fluid. One of skill in the art reading Bala would learn nothing about fluid

components or properties for use as a power transmission fluid. Even further, one reading Bala would learn nothing about obtaining a friction versus velocity curve with a more positive slope at high speeds for power transmission fluids.

The presently claimed invention provides a significant improvement over the prior art by providing a transmission fluid that provides a small friction drop at high speeds. See for example, the Table on page 26 in which transmission fluid VIIA has a friction drop of less than 0.008 at max-min and max-300 compared to transmission fluids not containing the polyisoalkylene component of the presently claimed invention. Bala teaches using many different types of components many of which are disclosed in the examples of the present application as providing results outside the scope of the claims. The only way to arrive at the presently claimed invention after reading Bala is upon impermissible hindsight after reading the present application.

The references Performance Filtration, Inc., Mark Barnes, and Science and Engineering Encyclopedia do not make up for the deficiencies of Bala and do not disclose, teach, or suggest anything about improved friction performance of a transmission fluid by including a polyisoalkylene component.

Therefore, independent claims 1 and 21 and their dependent claims are novel over Bala. For the same or similar reasons, new claims 51 and 52 are likewise novel over Bala.

### **REJECTIONS UNDER § 103(a)**

#### **US 6,300,290 (L'Heureux) in view of US 6,468,948 (Rossi)**

Claims 38, 39, 41, 42, and 47 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of US 6,468,948 to Rossi ("Rossi"). This rejection is traversed for at least the following reasons.

Nothing in L'Heureux, Rossi, or their combination discloses, teaches, or suggests anything about the additive concentrate for a transmission fluid of claim 38 comprising a polyisoalkylene component and having a friction versus velocity curve with a more positive slope at high speeds compared to a fluid not containing polyisoalkylene. Further, none of

L'Heureux, Rossi, or their combination discloses, teaches, or suggests an additive concentrate for a transmission fluid that has a friction drop at high speeds of less than about 0.008.

L'Heureux discloses an oil composition useful as a two-cycle oil or an engine oil. An engine oil is different from a power transmission fluid. The Office Action points to column 1, lines 30-43 of Rossi to support an erroneous statement that "it would have been obvious to also utilize the fuel composition disclosed by L'Heureux as a power transmission fluid." Such a statement is not only incorrect, it is not an accurate interpretation of Rossi. Rossi states in column 1, lines 30-43 that hydrocarbon oil and fuel oil compositions typically include additives to enhance performance. One may infer from the rest of the paragraph that depending upon the application, such performance requirements may overlap. But Rossi does not state that one fluid may be substituted for another.

One of skill in the art reading L'Heureux or Rossi would learn nothing about fluid components or properties for use as a power transmission fluid. Even further, one reading L'Heureux or Rossi would learn nothing about obtaining a friction versus velocity curve with a more positive slope at high speeds for power transmission fluids.

The presently claimed invention provides a significant improvement over the prior art by providing a transmission fluid that provides a small friction drop at high speeds. See for example, the Table on page 26 in which transmission fluid VIIA has a friction drop of less than 0.008 at max-min and max-300 compared to transmission fluids not containing the polyisoalkylene of the presently claimed invention.

Therefore, independent claim 38 and its dependent claims are nonobvious over L'Heureux in combination with Rossi. For the same or similar reasons, new claims 51 and 52 are likewise nonobvious over L'Heureux in combination with Rossi.

US 6,300,290 (L'Heureux) in view of US 4,912,272 (Wu)

Claims 7 and 27 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of US 4,912,272 to Wu ("Wu"). This rejection is traversed for at least the following reasons.

Nothing in L'Heureux, Wu, or their combination discloses, teaches, or suggests anything about the power transmission fluid composition of claim 1 or the method of improving shear

stability for a transmission fluid of claim 21 comprising a polyisoalkylene component and having a friction versus velocity curve with a more positive slope at high speeds compared to a fluid not containing polyisoalkylene. Further, none of L'Heureux, Wu, or their combination discloses, teaches, or suggests an additive concentrate for a transmission fluid that has a friction drop at high speeds of less than about 0.008.

L'Heureux discloses an oil composition useful as a two-cycle oil or an engine oil. An engine oil is different from a power transmission fluid. One of skill in the art reading L'Heureux or Wu would learn nothing about fluid components or properties for use as a power transmission fluid.

The presently claimed invention provides a significant improvement over the prior art by providing a transmission fluid that provides a small friction drop at high speeds. See for example, the Table on page 26 in which transmission fluid VIIA has a friction drop of less than 0.008 at max-min and max-300 compared to transmission fluids not containing the polyisoalkylene of the presently claimed invention.

Therefore, independent claims 1 and 21 and their dependent claims 7 and 27 are nonobvious over L'Heureux in combination with Wu. For the same or similar reasons, new claims 51 and 52 are likewise nonobvious over L'Heureux in combination with Rossi.

US 6,300,290 (L'Heureux) in view of US 6,468,948 (Rossi) and US 4,912,272 (Wu)

Claim 40 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of Rossi and Wu. This rejection is traversed for at least the following reasons.

Claim 40 is dependent upon claim 38. As discussed above, claim 38 is nonobvious in view of L'Heureux in combination with Rossi. Likewise, Wu does not disclose or suggest anything that would make up for the deficiencies in that combination.

Therefore, independent claim 38 and its dependent claim 40 are nonobvious in view of L'Heureux in view of Rossi and Wu.

US 6,300,290 (L'Heureux) in view of US 6,468,948 (Rossi) and US 6,444,622 (Bala)

Claims 43-47 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of Rossi and Bala. This rejection is traversed for at least the following reasons.

Claims 43-47 are dependent upon claim 38. As discussed above, claim 38 is nonobvious in view of L'Heureux in combination with Rossi. Likewise Bala does not disclose or suggest anything that would make up for the deficiencies in that combination.

Therefore, independent claim 38 and its dependent claims 43-47 are nonobvious in view of L'Heureux in combination with Rossi and Bala.

US 6,300,290 (L'Heureux) in view of US 6,103,673 (Sumiejski)

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of US 6,103,673 to Sumiejski ("Sumiejski"). This rejection is traversed for at least the following reasons.

Nothing in L'Heureux, Sumiejski, or their combination discloses, teaches, or suggests anything about the power transmission fluid of claim 1 comprising a polyisoalkylene component and having a friction versus velocity curve with a more positive slope at high speeds compared to a fluid not containing polyisoalkylene. Further, none of L'Heureux, Sumiejski, or their combination discloses, teaches, or suggests an additive concentrate for a transmission fluid that has a friction drop at high speeds of less than about 0.008.

L'Heureux discloses an oil composition useful as a two-cycle oil or an engine oil. An engine oil is different from a power transmission fluid. The Office Action points to column 19, line 56 through column 20, line 5 of Sumiejski to support an erroneous statement that "it is known in the art for two-cycle lubricants to also be utilized in automatic and constantly variable transmissions." Such a statement is not only incorrect, it is not an accurate interpretation of Sumiejski. Sumiejski states in column 19, line 56 through column 20, line 5 that the components disclosed in Sumiejski may find application in various parts of a vehicle. It does not state that finished fluids designed for a particular application (e.g., an engine oil) are interchangeable with a fluid for an entirely different part of a vehicle (e.g., a power transmission). Sumiejski does not state that one fluid may be substituted for another.

One of skill in the art reading L'Heureux or Sumiejski would learn nothing about obtaining a friction versus velocity curve with a more positive slope at high speeds for power transmission fluids. The presently claimed invention provides a significant improvement over the prior art by providing a transmission fluid that provides a small friction drop at high speeds. See for example, the Table on page 26 in which transmission fluid VIIA has a friction drop of less than 0.008 at max-min and max-300 compared to transmission fluids not containing the polyisoalkylene of the presently claimed invention.

Therefore, independent claim 1 and dependent claims 18 and 19 are nonobvious over L'Heureux in combination with Sumiejski. For the same or similar reasons, new claims 51 and 52 are likewise nonobvious over L'Heureux in combination with Sumiejski.

US 6,300,290 (L'Heureux) in view of US 6,468,948 (Rossi) and US 6,103,673 (Sumiejski)

Claims 48 and 49 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of Rossi and Sumiejski. This rejection is traversed for at least the following reasons.

Claims 48 and 49 are dependent upon claim 38. As discussed above, claim 38 is nonobvious in view of L'Heureux in combination with Rossi. Likewise Sumiejski does not disclose or suggest anything that would make up for the deficiencies in that combination.

Therefore, independent claim 38 and its dependent claims 48 and 49 are nonobvious in view of L'Heureux in combination with Rossi and Sumiejski.

US 6,300,290 (L'Heureux) in view of US 6,103,673 (Sumiejski) and US 2002/0130010 (Landa)

Claim 20 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of Sumiejski and US 2002/0130010 to Landa ("Landa"). This rejection is traversed for at least the following reasons.

Claim 20 is dependent upon claim 1. As discussed above, claim 1 is nonobvious in view of L'Heureux in combination with Sumiejski. Likewise Landa does not disclose or suggest anything that would make up for the deficiencies in that combination.

Therefore, independent claim 1 and its dependent claim 20 are nonobvious in view of L'Heureux in combination with Sumiejski and Landa.

US 6,300,290 (L'Heureux) in view of US 6,468,948 (Rossi), US 6,103,673 (Sumiejski), and US 2002/0130010 (Landa)

Claim 50 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over L'Heureux in view of Rossi, Sumiejski, and Landa. This rejection is traversed for at least the following reasons.

Claim 50 is dependent upon claim 38. As discussed above, claim 38 is nonobvious in view of L'Heureux in combination with Rossi and Sumiejski. Likewise Landa does not disclose or suggest anything that would make up for the deficiencies in that combination.

Therefore, independent claim 38 and its dependent claim 50 are nonobvious in view of L'Heureux in combination with Rossi, Sumiejski, and Landa.



## CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

## FEES

Please debit a fee of \$620 from Deposit Account No. 12-2355 for an extension of time of one-month (\$120) and for two additional independent claims (\$500). It is the belief of the undersigned attorney that there are no other fees associated with this filing. However, in the event that the calculations are incorrect, the Commissioner is authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355.

Respectfully submitted,



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